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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/539,790

06/17/2005

Jutta Arden-Jacob

ARDEN-JACOB-3

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EXAMINER

POWERS, FIONA

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/539,790	Applicant(s) ARDEN-JACOB ET AL.	
	Examiner Fiona T. Powers	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 26-33 is/are pending in the application.
- 4a) Of the above claim(s) 13, 14, 16-20 and 26-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12 and 21-24 is/are rejected.
- 7) ☒ Claim(s) 9-11 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/19/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Receipt is acknowledged of the preliminary amendment filed September 15, 2005 and the information disclosure statement filed December 19, 2005, which have been entered in the file.

The restriction requirement mailed May 16, 2008 contained an error. Claim 15 was not placed in any of the groups. Claim 15 should have been placed in Group 1 since Y is oxygen in this claim. In addition, claim 14 should not have been grouped in Groups 1 to 6 since Y is not oxygen, sulfur, selenium, CR_aR_b , NR_c or a direct linkage in this claim. Claim 14 should only be a part of Group 7. The election described below has been modified accordingly.

Applicant's election with traverse of Group I (claims 1 to 12, 15 and 21-24 all in part and claims 12 and 15 where Y is oxygen) in the reply filed on August 18, 2008 is acknowledged. The traversal is on the ground(s) that the elected preparation claims are so closely related to the non-elected process claims, that they should remain in the same application to preserve unity of invention. Applicants further discuss how the claimed process differs from the processes disclosed in WO 00/64988, WO 02/055512 and EP 167998. Applicants also state that the special technical feature of all of the dyestuffs is the ortho-carboxy-phenyl substituents at the central chromophore. This is not found persuasive because the special technical feature common to

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all of the claims is the carboxamide-substituted dye of the formula I. These compounds have a $-\text{COHR}_5\text{R}_6$ group substituted on the Cyc1 cyclic group. These dyes are known in the prior art. Note the rejections below.

The requirement is still deemed proper and is therefore made FINAL.

Claims 13, 14, 16 to 20 and 26 to 33 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on August 18, 2008.

The disclosure is objected to because of the following informalities: the specification does not contain a section entitled "BRIEF DESCRIPTION OF THE DRAWINGS". This heading should be placed at the top of page 23.

Appropriate correction is required.

Claims 1 to 12, 15 and 21 to 24 are objected to because of the following informalities: the claims contain non-elected subject matter. Appropriate correction is required.

Claim 15 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should depend on other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim 15 has not been further treated on the merits.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The "ring system" as recited in claim 7 does not find antecedent basis in claim 6.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 to 5 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Mayer et al. (US 4647675) or Yanagihara et al. (US 5389489) or Haugland et al. (US 6399392) or Japanese Patent 11-302550 or Japanese Patent 2000-118145, cited.

The references disclose the claimed carboxamide-substituted dyes of the formula (1) wherein Y is oxygen; Cyc1 is an aromatic or heteroaromatic ring system (e.g. phenyl or pyridyl); Cyc2 is an aromatic or heteroaromatic ring system; R₂ is NR₇R₈ where R₇ and R₈ are hydrogen or a hydrocarbon group; R₁, R₃ and R₄ are independently selected from hydrogen or a straight-chain, branched or cyclic saturated or unsaturated hydrocarbon group; and R₄ and R₅ are independently selected from a straight-chain, branched or cyclic saturated or unsaturated hydrocarbon group. Note Examples 4 and 5 in column 5 of Mayer et al; column 4, lines 42 to 45 and column 5, lines 26 to 30 of Yanagihara et al.; Compound Nos. 10 and 11 in columns 31 and 32 and Compound No. 27 in column 40 of Haugland et al; Compound Nos. 4 and 10 to

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16 on pages 4 to 6 of JP 11-302550; and Compound No. 1-15 on page 21 of JP 2000-118145.

Claims 1, 3, 4 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent 62-94841, cited or Gao et al. (WO 02/055512), cited by applicants.

The references disclose the claimed carboxamide-substituted dyes of the formula (1) wherein Y is oxygen; Cyc1 is an aromatic ring system (e.g. phenyl); Cyc2 is an aromatic ring system of the structure (B); R₂ is O-R₉ where R₉ is hydrogen or a straight-chain, branched or cyclic saturated or unsaturated hydrocarbon group; and R₄ and R₅ are independently selected from a straight-chain, branched or cyclic saturated or unsaturated hydrocarbon group. Note Examples 6, 8 and 10 on page 5 of JP 62-94841 and Examples 2-7, 9 and 14 and Compound Nos. 3 to 8 of Figure 2 of Gao et al.

Claims 21 to 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Haugland et al. (US 6399392) or Gao et al. (WO 02/055512).

The references disclose the claimed process for the preparation of the carboxamide-substituted dyes of the formula (1) wherein the dye of the formula (II) is activated then reacted with a secondary amine. The dye of the formula (II) may be activated with N-hydroxysuccinimide, for example. Note

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Examples 5 and 16 of Haugland et al.; and page 8, line 8 to page 9, line 30 and Examples 1 to 7, 9 and 14 of Gao et al.

Claims 1 to 8 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Chiarello et al. (US 6750357), cited.

The reference discloses the claimed carboxamide-substituted dyes of the formula (1) wherein Y is oxygen; Cyc1 is an aromatic or heteroaromatic ring system; Cyc2 is an aromatic or heteroaromatic ring system of the formula (A) or (G); R₂ is NR₇R₈ where R₇ and R₈ are each a hydrocarbon group; R₁, R₃ and R₄ are hydrogen; and R₄ and R₅ are a hydrocarbon group. Note Compound Nos. 1 to 9 of Table 1.

The references made of record and not relied upon show the state of the art.

Claims 9 to 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T.

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Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fiona T. Powers/
Primary Examiner, Art Unit 1626

Fiona T. Powers
Primary Examiner
Art Unit 1626

ftp
November 10, 2008